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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Zhichen Xu et al.

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Examiner: Samson B. Lemma

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Group Art Unit: 2132

Title: INCREASING PEER PRIVACY

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated April 10, 2006, kindly consider the following remarks. This request is being filed concurrently with a Notice of Appeal.

Claims 1-36 are pending, of which claims 1, 14, 18, 22 and 24 are independent.

Claims 1-36 were rejected under 35 U.S.C. §103(u) as being unpatentable over Walker et al. (5,862,223), referred to as Walker, in view of Herz (6,460,036).

According to embodiments described in the Applicants' specification, an anonymous network path is determined and formed between peers in a computer network, wherein the peers include computing platforms. Peers may exchange data using the anonymous network path, and the anonymous network path minimizes the ability of malicious users determining the source or destination of sensitive information.

Walker is unrelated to forming anonymous network paths. Walker, in contrast, describes a method for an end user to get answers from experts. For example, an end user needs expert review of an academic paper or needs an answer to a question about running the

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user's business. See column 11, lines 12-55. The end user submits a request for a human expert qualified to respond to the user's question to a central controller. The central controller searches a database for an expert that is qualified to respond to the user request. The central controller sends the request to an expert if a qualified expert is found. The expert responds to the request. See columns 35-36. A path including a plurality of peers in a network is not determined or transmitted.

Claim 1 recites peers include computing platforms and determining whether a data provider exists that stores the requested data; wherein the data provider is a peer of the peers.

Neither Walker nor Herz teach or suggest determining whether a computing platform exists that stores requested data. The rejection of claim 1 states that a controller receives an expert request/requested data and a search program identifies experts qualified to respond to the experts. Walker discloses selecting an expert qualified to respond to a request. However, Walker fails to teach or suggest determining whether a computer stores the requested data. Selecting a qualified expert does not include determining whether a computer exists that stores the requested data. An expert in Walker is a human not a computer. Walker only discloses selecting an expert that is allegedly qualified to respond to a request, but does not determine whether the expert stores requested data in a computer or otherwise knows the answer to a request.

The rejection of claim 1 further alleges Herz discloses determining whether a data provider exists that stores requested data in column 38. Herz discloses that after a user has registered with the proxy server S2, the user may use the services of the proxy server to interact with service providers. For example, the user sends a request to S2 to communicate with the server S4 using a pseudonym P. However, Herz fails to teach or suggest

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determining whether the server S4 or any other server stores requested data. Instead, Herz simply transmits a message to a destination using a pseudonym P.

Furthermore, the rejection fails to establish a *prima facie* case of obviousness because no motivation was provided for combining the alleged teaching of determining whether a data provider exists that stores requested data in column 38 of Herz with Walker.

Claim 1 recites selecting a plurality of the peers to form a path between said data provider and said data requestor, wherein said data provider and said data requestor are the respective ends of said path.

Walker fails to teach or suggest selecting a plurality of peers between a data provider and a data requestor. Columns 35-36 of Walker describe an example of submitting and responding to an end user request. Alice the end user submits a request to the trusted third party/central controller, Carol. Carol selects an expert, Bob, for responding to the request. Carol sends the request to Bob. Bob sends the answer to Carol and Carol sends the answer to Alice. The path in Walker only includes a single person, Carol, between the data provider, Bob, and the data requestor, Alice. Thus, Walker fails to teach or suggest selecting a plurality of peers between a data provider and a data requestor.

The rejection alleges that selecting a plurality of the peers is inherent in Walker because if the experts' answers come from a plurality of experts for the same data request, the controller will inherently form a path between said provider and data requestor.

A claim element not explicitly taught by the prior art may be an inherent feature of the prior art. However, it is the burden of the Examiner and not the Applicants to prove that the claimed feature is inherent. Secondly, to establish inherency, the Examiner must make clear that the missing descriptive matter is *necessarily present* in the thing described in the

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reference, and that it would be so recognized by persons of ordinary skill. "Inherency, however, *may not be established by probabilities or possibilities*. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

The controller in Walker does not inherently form a path between an expert and a person requesting an answer. As described above, the controller in Walker, such as Carol, only selects an expert and sends the request to the expert. No path is formed by the controller. The controller only sends the request to the expert, but the controller does not form the path and does not select a plurality of peers/computers that are to be used in the path between the provider and requestor. Sending a request to an expert does not require forming a path. Although not disclosed in Walker, even if the Examiner is alleging that the controller transmits the request via a network to the expert, the controller does not form the path in the network and does not select a plurality of peers to be used in the network path.

Also, if a plurality of experts are responding to a single request, Walker fails to teach or suggest that each expert selects a plurality of peers to be used in path. Columns 35 and 36 of Walker cited in the rejection fail to teach or suggest a plurality of experts responding to a single request. Instead, the single expert, Bob, selected by the controller, Carol, sends the answer to Carol, and Carol sends the answer to the requestor, Alice. A plurality of peers are not selected by Carol or Bob to be used in the path between Bob and Alice.

Independent claim 18 recites the peers include computer platforms; determine whether a data provider exists that stores the requested data, wherein the data provider is a peer of the peers; and select a plurality of the peers to form a path between said data provider

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and said data requestor. Independent claim 24 recites similar features. These features are not taught or suggested by Walker in view of Herz for the reasons stated above.

Independent claim 14 recites the mix includes an anonymous identity of each of a plurality of peers in a path between a data provider and a data requestor in the network.” Independent claim 22 recites peers include computer platforms, and a mix configured to provide a path among a plurality of the peers between a data provider and a data requestor in the network. Walker in view of Herz fails to teach or suggest a plurality of peers in a path between a data provider and a data requestor. The path in Walker only includes a single person, Carol, between the data provider, Bob, and the data requestor, Alice.

Respectfully submitted,

Dated: June 1, 2006

By



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